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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,305	12/15/2003	Antonio J. Aldykiewicz JR.	L3862-01	5459

33250 7590 09/26/2006

W. R. GRACE & CO.-CONN
ATTENTION: PATENT DEPARTMENT
62 WHITTMORE AVENUE
CAMBRIDGE, MA 02140

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/736,305		ALDYKIEWICZ ET AL.	
	Examiner		Art Unit	
	Yvonne M. Horton		3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8-10 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,148,644 to WEIR in view of US Patent #6,295,781 to THOMPSON. WEIR discloses the method of minimizing corrosion of metal devices (nails-not labeled), column 6, lines 34-40, in pretreated, column 4, lines 28-31, wood constructions including the step of capping the ends of a plurality of wood joists (16) with a membrane barrier (as at 20,40) having a carrier support layer (30',41) attached to a pressure sensitive (compressible), column 4, lines 20-23, waterproofing layer (19); and connecting the capped ends, see figure 15, column 5, lines 26-33, to a rim wood joist (16') or to another wood structural member (17) such that the pressure sensitive (compressible) waterproofing layer (19) seals around metal fasteners driven therethrough, column 2, lines 37-42, thereby preventing contact between the posts (14), joists (16) and rim joists (16'). WEIR discloses the basic claimed method except for the except for the pressure sensitive layer specifically being an adhesive and except for the joists being joined using a metal joist hanger. In reference to the pressure sensitive adhesive, although WEIR does not specifically disclose that his layer is an adhesive, he does detail that it is secured, explicit of how. Although WEIR is silent in this regard, the compressive layer (19) of WEIR is functionally equivalent to the requirements set forth in the claim. For instance the claim requires that the adhesive seal around the fastener.

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Clearly, column 2, lines 37-42, WEIR, functions similarly. Regarding the issue of the use of a metal joist hanger, WEIR does not specifically detail the use of a metal joist hanger; however, he does stipulate that the joist, posts, and girders are secured by nailing or "as desired". The use of joist hangers are old and very well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use joist hangers in order to properly secure the posts, girders and joists. In further support, THOMPSON, teaches that it is known in the art to provide a wood structure with a metal joist hanger (10) in order to aid in connecting the joists (S) and rim joists (T1,T2). Thus, it would have been obvious to one having ordinary skill in the art to provide the structure of WEIR with the metal joist hanger of THOMPSON, in order to strengthen the connection of the structural members. Metal hangers give added rigidity and provides for an ease of seating one member with regards to another. In reference to claim 9, the membrane (20) is applied to an upper surface of the ends of the longitudinal length of the joists. Regarding claim 10, the membrane (20) is non-water absorptive (i.e. waterproof), column 1, line 56. In reference to claim 14, WEIR is silent with regards to the material used to form his fasteners. However, galvanized steel fasteners are old and very well known in the art. Thus, it would have been obvious to one having ordinary skill in the art to select a known material suitable for the use intended as an obvious matter of design choice. For instance in structures having smaller load requirements nylon or perhaps plastic fasteners might be appropriate. However, in structures having larger load requirements steel fasteners are more appropriate.

Response to Arguments

Applicant's arguments filed 07/13/06 have been fully considered but they are not persuasive.

Regarding the applicant's argument that WEIR "solves a different problem", the applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In reference to the applicant's argument that WEIR does not teach pre-treating his wood, a closer look at WEIR reveals that he does pre-treat his wood, column 4, lines 28-31.

Regarding the applicant's argument that the waterproofing material is not "pressure sensitive", the applicant's attention is brought to column 4, lines 20-23 of WEIR, where it is disclosed that the waterproofing material is "compressive" which is a common equivalent to or known a responding or being "sensitive" to pressure.

In reference to the applicant's argument that WEIR does not teach the use of a metal hanger, the examiner agrees in part. AS noted above, WEIR, column 6, lines 28-31, discloses that his members are connected using nails or as desired. The use of joist hangers are old and very well known in the art because they give added rigidity and provides for an ease of seating one member with regards to another. Thus, THOMPSON details the use of joist to connect girders, posts, and rim joists. WEIR is not used as a teaching for joist hangers, THOMPSON teaches this.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yvonne M. Horton
Examiner
Art Unit 3635

09/20/06


JEANETTE E. CHAPMAN
PRIMARY EXAMINER
GROUP 3400